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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,147	05/30/2001	Toshiaki Tsuboi	10746/26	8853
26646	7590	02/14/2006	EXAMINER	
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				PASS, NATALIE
ART UNIT		PAPER NUMBER		
				3626

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/870,147	TSUBOI ET AL.
	Examiner	Art Unit
	Natalie A. Pass	3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 December 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the response filed 05 December 2005. No claims have been amended. Claims 1-17 are pending.

Claim Rejections - 35 USC § 101

2. The rejection of claim 17 under 35 U.S.C. 101 is hereby withdrawn due to the response filed 05 December 2005.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 7, 9-10, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strecher, U.S. Patent Number 5, 207, 580 for substantially the same reasons given in the previous Office Action (paper number 08312005). Further reasons appear hereinbelow.

Art Unit: 3626

(A) Claims 1-2, 7, 9-10, 15, and 17 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 08312005, section 5, pages 3-6), and incorporated herein.

5. Claims 3-4 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strecher, U.S. Patent Number 5, 207, 580 as applied to claims 2 and 10 above, and further in view of Rieger et al. article: "Development of an Instrument To Assess Readiness to Recover in Anorexia Nervosa." 2000. URL: <<http://www3.interscience.wiley.com/cgi-bin/fulltext/74000261/PDFSTART>>, hereinafter known as Rieger for substantially the same reasons given in the previous Office Action (paper number 08312005). Further reasons appear hereinbelow.

(A) Claims 3-4 and 11-12 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 08312005, section 6, pages 6-8), and incorporated herein.

6. Claims 5-6, 8, 13-14, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strecher, U.S. Patent Number 5, 207, 580 as applied to claims 1 and 9 above, and further in view of Douglass et al., U.S. Patent Number 6, 039, 688 for substantially the same reasons given in the previous Office Action (paper number 08312005). Further reasons appear hereinbelow.

(A) Claims 5-6, 8, 13-14, 16 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 08312005, section 7, pages 8-10), and incorporated herein.

Response to Arguments

7. Applicant's arguments filed 05 December 2005 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 05 December 2005.

(A) At page 2-3 of the 05 December 2005 response, Applicant argues that the rejection of claim 17 under 35 U.S.C. §101 should be withdrawn. Applicant's argument is persuasive, and consequently the 35 U.S.C. §101 rejection has been withdrawn.

(B) At pages 3-4 of the 05 December 2005 response, Applicant argues that the features in the Application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes as missing in the applied references have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Strecher, Rieger, and Douglass, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 08312005), and incorporated herein. Specifically, Examiner notes that the recited features of "obtaining a scenario which includes health promotion information and health

promotion timing for each of levels of readiness for change” are taught by the combination of applied references. In particular, Examiner interprets Strecher’s teaching of collecting data “about the pattern and history of the health-related behavior” to be a “scenario.” (Strecher; column 2, line 53 to column 3, line 5, column 4, lines 5-31), and as teaching these limitations.

In the paragraph bridging pages 3-4 of the 05 December 2005 response, Applicant argues that the “reference does not disclose the use of scenarios.” Examiner respectfully disagrees. Although the Strecher reference does not mention the word “scenario” per se, Examiner has looked to Applicant’s own specification as well as to two dictionaries to interpret this term. Examiner notes that Applicant recites: “[t]he scenario preparation part 6 prepares standard health promotion details (the scenario) by using the health promotion information 1 for lifestyles and diseases and the like which are input by the health promotion practitioner. The scenario storing part 7 stores the scenario” (emphasis added) (Specification, page 10, lines 6-11). In addition, the Terminology Reference System of EPA defines “scenarios” to be ”conditions of the environment chosen for a given survey or activity” (URL:

<http://iaspub.epa.gov/trs/trs_proc_qry.navigate_term?p_term_id=974&p_term_cd=TERM>

and the online dictionary Wikipedia defines “scenario analysis” to be “a process of analyzing possible future events by considering alternative possible outcomes (scenarios). The analysis is designed to allow improved decision-making by allowing more complete consideration of outcomes and their implications” (URL: <http://en.wikipedia.org/wiki/Scenario_analysis>). As such, Examiner interprets Strecher’s teachings of:

“In the preferred embodiment of the invention the preparation phase lasts approximately one week, and initiates the health-related behavior change process. To create tailored

3advice [reads on “health promotion information”] during this stage, the computer algorithm primarily uses data collected about the pattern and history of the health-related behavior. For some health-related behaviors that may never have been performed in the past (e.g., exercise, adherence to a particular drug), pattern and history data will not be relevant and are not elicited or incorporated into the algorithm. However, for many behaviors such as cigarette smoking, excessive alcohol consumption and dietary behavior, pattern and history data are extremely relevant and are used in the algorithm. In particular, frequency and duration of the behavior, cues normally initiating the behavior, and previous attempts to modify the behavior are elicited and used to create instructions and advice for use during the preparation phase. During the preparation phase, motives cited by the user are also analyzed and incorporated into the algorithm, which provides instructions intended to internalize motives for changing” (Strecher; column 4, lines 5-27)”

to teach “obtaining a scenario which includes health promotion information and health promotion timing.”

In addition, Examiner notes that claims 1-17 were rejected under 35 USC § 103 and not 35 USC § 102, and further notes that although the term “scenario” is not mentioned, the Strecher reference states that “[i]t is therefore an object of this invention to provide a tailored health-related behavior change and adherence system which can be made available to persons desiring to change an unhealthy behavior and/or maintain a healthy behavior” (Strecher; column 1, lines 35-40), consequently providing the motivation that it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize or “incorporate” such information “into the algorithm” with the motivations of “initiat[ing] the health-related behavior change process” and “to create tailored advice” using data collected about the pattern and history of the health-related behavior (reads on “scenarios”) (Strecher; column 4, lines 5-27).

In response to Applicant's argument in pages 4-5 of the 05 December 2005 response that there is no suggestion to combine the references, the Examiner notes that the motivations for combining the applied references can be found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the instant application the motivations have been found in the references themselves. For example, the Examiner has noted that motivation to combine "scenarios" with the Strecher reference is as stated above; and in the previous Office action (paper number 08312005), Examiner noted the motivations to combine Strecher with the Rieger reference (i.e. "with the motivations of increasing the effectiveness of interventions ... since "readiness to change predicts aspects of behavioral and attitudinal change"""), which is taken solely from the teachings of Rieger (Rieger; page 395, paragraph 4, page 388, paragraph 4); and the motivations to combine Strecher with Douglass, (i.e. "with the motivations of providing a therapeutic program that could effectively motivate patients to modify their behavior ... with their programs," which is taken solely from the teachings of Douglass (Douglass; column 1, line 61 to column 2, line 2)).

Furthermore, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of

one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Consequently, it is respectfully submitted that contrary to Applicant's allegations, the features that Applicant disputes are clearly within the teachings of the applied references and that Applicant fails to properly consider the clear and unmistakable teachings of the applied references, as illustrated above.

Moreover, with respect to Applicant's argument that a *prima facie* case of obviousness has not been established the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence has been presented of corresponding claim elements in the prior art and the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see paper number 08312005) and present Office Action) have been expressly articulated.

In response to Applicant's argument at pages 4-5 of the 05 December 2005 response that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be

recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

With regard to Applicant's argument in pages 5-7 of the 05 December 2005 response that the applied prior art fails to disclose the argued limitations, and further that there is no motivation to combine the references, these issues have been discussed earlier in this action.

Conclusion

8. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to: (571) 273-8300.

For formal communications, please mark
"EXPEDITED PROCEDURE".

For informal or draft communications, please label
“PROPOSED” or “DRAFT” on the front page of the
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

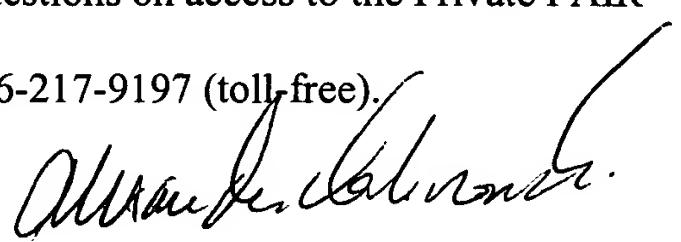
11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).



Natalie A. Pass

February 8, 2006



ALEXANDER KALINOWSKI
SUPERVISORY PATENT EXAMINER